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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/775,171	02/11/2004	John V. Bernardi	OMG/168/US	1006
2543 7590 10/07/2008 ALIX YALE & RISTAS LLP 750 MAIN STREET SUITE 1400 HARTFORD, CT 06103				
EXAMINER				
NGUYEN, CHI Q				
ART UNIT		PAPER NUMBER		
3635				
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10/07/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/775,171

**Applicant(s)**

BERNARDI ET AL.

**Examiner**

CHI Q. NGUYEN

**Art Unit**

3635

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 28 April 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) 1, 8-15 and 20-24 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2-7, 16-19 and 25-36 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/S508)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Election/Restrictions***

Applicant's election with traverse of Species 1: Fig. 7 in the reply filed on 4/28/2008 is acknowledged. The traversal is on the ground(s) that the action on the merits has already been previously issued for all the pending claims, proceeding to presecute all of the claims would not present an undue burden. This is not found persuasive because the applicant's invention contains several different species that drawn to different inventions thus the restriction is necessitated although the action is already on the merits.

The requirement is still deemed proper and is therefore made FINAL.

### ***Status of Claims***

Claims 2-7, 16-19 and 25-36 are pending.

Claims 8-12, 14-15, 20-24 are drawn to non-elected claims and being withdrawn.

Claims 1 and 13 has been cancelled.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 2-7 and 25-30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In regarding to independent claim 25, a citation "the fixed mounting of roof membrane seam plates" does not have antecedent basis. Correction is required. Claims 2-7 and 26-30 depending upon the rejected claim 25 are also rejected.

Regarding claim 25, citations "will likewise" and "the remaining ones" are indefinite.

Regarding claim 31, a citation "will likewise" is indefinite, vague and confusing.

Correction is required. Claims 16-19 and 32-36 depending upon the rejected claim 31 are also rejected.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 25-30, 2-7, 16-19 and 31-36 stand rejected under 35 U.S.C. 103(a) as being unpatentable over US Pat. No. 4,382,353 to Kelly in view of US Pat. No. 4,787,188 to Murphy.

Claims 25 and 27:

Kelly discloses an assembly of reverse furring technique comprising: a substrate 11, comprising at least one ply, having a longitudinal extent and predetermined first transverse dimension as defined between oppositely disposed side edge portions; and a plurality of fastener 21, for fixing environmental membranes upon an underlying an underlying roof decking substructure, having second transverse dimensions which are not greater than said first transverse dimensions of said substrate so as to be fixedly

mounted upon said at least one ply of said substrate in such a manner that said plurality of fastener are disposed transversely inwardly between said oppositely disposed side edge portions of said substrate, and at predeterminedly spaced positions spaced along said longitudinal extent of said substrate, so as to define with said substrate an integral product entity such that when a first one of said plurality of fastener is fixedly secured at a first location along the underlying roof decking substructure by means of said fastener, the remaining ones of said plurality of fastener, fixedly attached to said substrate at said predetermined positions spaced along said longitudinal extend of said substrate. Kelly discloses the basic structures for an assembly of reverse furring technique as stated above but does not expressly disclose the assembly comprises a plurality seam plates are to be fixedly secured by the fasteners so as to ensure the proper fixation of said seam plates to the underlying roof decking substructure whereby, in turn, the fixation of the environmental membranes upon the underlying roof decking substructure, will likewise be ensured. Murphy discloses stress plate or seam plate for securing a roof membrane to a roof deck comprising a plurality of 10 and each of the seam plate 11 having opening 15 for receiving an appropriate fastening means such as screws (see Fig. 1, col. 2, lines 1-2). At the time of the invention was made, it would have been obvious to a person having an ordinary skill in the art to combine Kelly with Murphy for a plurality of seam plates for securely attached roofing membranes more securement and preventing back-out fasteners that normally caused by strong wind,.

Claim 26:

Wherein said substrate comprises a structure selected from the group comprising a suitable metal sheet strip (col. 2, line 24).

Claims 28 and 5:

Wherein said substrate comprises a flattened tubular member and said plurality of seam plates are fixedly secured within said tubular member by means of adhesive material (see col. 2, line 49. Note that the limitation of "heat-sealed" would have been considered method of forming a device and is not germane to the issue of patentability of the device itself. Therefore, this limitation has not been given patentable weight.

Claims 29-30:

Kelly in view of Murphy disclose the basic structures for the roofing structures as stated but do not disclose expressly wherein said substrate is fabricated from a suitable material which exhibits a sufficient amount of flexibility so as to permit said substrate to be rolled into a coiled form and wherein said substrate is fabricated from a suitable material which exhibits a sufficient amount of flexibility so as to permit said substrate to be folded in a pleated array in order to permit said seam plates to be stacked in a nested array with respect to each other. A term "fabricated" would have been considered method of forming a device and is not germane to the issue of patentability of the device itself. Therefore, this limitation has not been given patentable weight.

Claims 2-3:

Kelly discloses the basic structures for a roofing assembly and further wherein when the underlying roof decking substructure comprises a corrugated 3 or non-corrugated 1 roof decking substructure, comprising a plurality of crest portions 5 spaced from each other by means of predetermined distances but does not disclose a plurality of seam plates are fixedly mounted upon said substrate at predeterminedly spaced positions which correspond to the predetermined distances defined between the plurality of spaced crest portions of the underlying corrugated roof decking substructure so as to ensure said plurality of seam plates can be fixedly secured to the plurality of spaced crest portions of the underlying corrugated roof decking substructure. Murphy discloses stress plate or seam plate for securing a roof membrane to a roof deck comprising a plurality of 10 and each of the seam plate 11 having opening 15 for receiving an appropriate fastening means such as screws (see Fig. 1, col. 2, lines 1-2). At the time of the invention was made, it would have been obvious to a person having an ordinary skill in the art to combine Kelly with Murphy for a plurality of seam plates for securely attached roofing membranes more securement and preventing back-out fasteners that normally caused by strong wind, etc.

Claims 4 and 6-7:

Kelly discloses the basic structures for a roofing assembly as stated but does not disclose expressly wherein each one of said plurality of seam plates has a plurality of projections extending downwardly from undersurface portions of each one of said plurality of seam plates for engaging each one of the environmental

membranes and said substrate has a substantially C-shaped cross-sectional configuration comprising an upper planar member disposed atop said plurality of seam plates and a pair of lower planar flap-type members folded inwardly from opposite side edge portions of said upper planar member. Murphy discloses stress plate or seam plate for securing a roof membrane to a roof deck comprising a plurality of 10 and each of the seam plate 11 having a plurality of projections or prongs 21 (see Fig. 3, col. 2, line 7) extending downwardly from undersurface portion of each one of said plurality of seam plate (see Figs. 1-2) and opening 15 for receiving an appropriate fastening means such as screws (see Fig. 1, col. 2, lines 1-2). At the time of the invention was made, it would have been obvious to a person having an ordinary skill in the art to combine Kelly with Murphy for a plurality of seam plates for securely attached roofing membranes more securement and preventing back-out fasteners that normally caused by strong wind, etc. Kelly in view of Murphy disclose the basic structures for a roofing assembly as stated but do not disclose the substrate has a substantially C-shape cross sectional configuration. However, this feature would have been a matter of obvious design choice to one of ordinary skill in the art at the time the invention was made to have such a C-shaped cross sectional substrate for desirable application. Furthermore, applicant has not disclosed the criticality of this feature.

Claim 31:



Kelly discloses an assembly of reverse furring technique comprising: an underlying roof decking substructure 3, an insulation panel 7 disposed atop said roof decking substructure, a plurality of environmental membranes 19 adapted to be fixedly / secured atop said insulation panel 7, at least one substrate 11, comprising at least one ply, having a longitudinal extent and predetermined first transverse dimension as defined between oppositely disposed side edge portions; and a plurality of fastener 21, for fixing environmental membranes upon an underlying an underlying roof decking substructure, having second transverse dimensions which are not greater than said first transverse dimensions of said substrate so as to be fixedly mounted upon said at least one ply of said substrate in such a manner that said plurality of fastener are disposed transversely inwardly between said oppositely disposed side edge portions of said substrate, and at predeterminedly spaced positions spaced along said longitudinal extent of said substrate, so as to define with said substrate an integral product entity such that when a first one of said plurality of fastener is fixedly secured at a first location along the underlying roof decking substructure by means of said fastener, the remaining ones of said plurality of fastener, fixedly attached to said substrate at said predetermined positions spaced along said longitudinal extend of said substrate. Kelly discloses the basic structures for an assembly of reverse furring technique as stated above but does not expressly disclose the assembly comprises a plurality seam plates are to be fixedly secured by the fasteners so as to ensure the proper fixation of said seam plates to the underlying roof

decking substructure whereby, in turn, the fixation of the environmental membranes upon the underlying roof decking substructure, will likewise be ensured. Murphy discloses stress plate or seam plate for securing a roof membrane to a roof deck comprising a plurality of 10 and each of the seam plate 11 having opening 15 for receiving an appropriate fastening means such as screws (see Fig. 1, col. 2, lines 1-2). At the time of the invention was made, it would have been obvious to a person having an ordinary skill in the art to combine Kelly with Murphy for a plurality of seam plates for securely attached roofing membranes more securement and preventing back-out fasteners that normally caused by strong wind.

Claim 32: See rejections of claim 26 above.

Claim 33: wherein said substrate 11 comprises at least a pair of substrates fixedly connected together along at least one longitudinally extending seam portion (Fig. 1).

Claim 34 and 17: See rejections of claims 28, 5, above.

Claims 35-36: See rejections of claims 29-30 above.

Claims 16, 18-19: See rejections of claims 4, 6-7, above.

### ***Response to Arguments***

Applicant argues that (the prior arts US Pat. No. 4,382,353 to Kelly and US Pat. No. 4,787,188 to Murphy) there is no suggestion to combine the references, has been considered but not persuasive because the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce

the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Kelly and Murphy are analogous art because they are from a similar problem solving area, e.g. roofing securement.

Since the examiner has raises the new 112, 2<sup>nd</sup> issues therefore the action will not made if final this time.

### ***Conclusion***

Any inquiry concerning this communication or earlier communication from the examiner should be directed to Chi Q. Nguyen whose telephone number is (571) 272-6847. The examiner can normally be reached on Monday-Friday from 7:30 am-4:00 pm.

If attempt to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Chilcot can be reached at (571) 272-6777.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pairedirect.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at (866) 217-9197.

/C. Q. N./  
Examiner, Art Unit 3635

/Richard E. Chilcot, Jr./

Supervisory Patent Examiner, Art Unit 3635